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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/689,379
Filing Date: October 20, 2003
Appellant(s): YARDLEY ET AL.

**MAILED
JAN 25 2008
GROUP 3700**

Robert C. Stanley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/17/07 appealing from the Office action
mailed 3/28/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,256,334	Lazar	2-1918
5,716,691	Chan	2-1998

4,469,243

Ito et al.

9-1984

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 80-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation “of at least about” (claim 80, line 5; claim 82, line 3; claim 84, line 5; claim 87, line 3) is indefinite. The scope of “about” is not clear. In paragraph 071, page 23 of the specification the ranges for the length are “about 9.5 – about 13.5 inches” and width “about 3 to about 7 inches”. A specific determination of what applicant intends to cover by “at least about 2 to 1” cannot be made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80-81, 84, 86, and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazar (US 1,256,334).

Lazar discloses a method of making a paper napkin comprising providing a single ply paper web with a longitudinal to transverse aspect ratio of about 2 to 1; folding one free edge towards the other edge to create two panels 3 and 4; folding the transverse fold 2 towards the free edge for a four paneled web; see figures 4 and 6. The panels have approximately equal areas.

Claims 84-85 and 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan (US 5,716,691).

Chan discloses a method of folding a web by folding a transverse free edge toward the other free edge creating a fold line and subsequently folding the fold line toward the transverse free edge creating another fold line and three panels; see figures 1 and 2a.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 82-83 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazar (US 1,256,334) in view of Applicant's Admitted Prior Art (AAPA).

Lazar does not directly disclose the ranges of dimensions, nor the weight per sq ft of the product. It would have been obvious to one of ordinary skill in the art to apply the

folding method of Lazar to various sizes and weights of webs including those of claims 82 and 87. The method of folding does not seem to be affected by the claimed dimensions or the claimed weight ratio and providing such a dimensioned or weighted web solves no stated problem. The previously made common knowledge modification is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice.

Claims 84-85 and 88-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 4,469,243).

Ito describes forming transverse folds in a web in order to produce wipes. The invention contemplates multiple fold configurations as well as materials; see column 7, lines 40+; figure 1.

Ito does not directly disclose the use of a single ply paper web (rather a four ply for added strength) however it would have been obvious to one of ordinary skill in the art to use the method for a single ply if desired; Applicant has not disclosed that a single ply paper web provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any web of foldable material because the method steps do not rely upon the material being folded.

Further note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

(10) Response to Argument

Applicant's arguments filed 12/17/07 have been fully considered but they are not persuasive.

The rejection under 35 USC 112 is maintained. It is not merely the mention of the term "about" which creates indefiniteness. Because the ranges are not specific ie. the claimed ranges (also described without precision in the specification) include the term "about", it is uncertain to what degree is encompassed. "At least about" a 2 to 1 ratio, which variables are also "about" a value is ambiguous, provided no further definition of scope. The ranges in the specification which are provided describe the longitudinal dimension ie. about 11 to about 17, not defining specific variables for the transverse dimension which are at least about this value. Note the discussion of the range of a transverse dimension which is about 3; see Specification, page 23. Two times this amount is about 6. Is this value considered "at least about" 9.5 inches on the lower range (the lowest found dimension for the longitudinal direction)? Note if 2 is considered about 3 then the calculation yields about 4. There is no indication of the variability involved in the calculation to determine what is encompassed by the scope.

Claiming the longitudinal dimension in terms of the unspecified transverse dimension yields ambiguity. No direction is given to one of ordinary skill in the art to determine the scope of what is claimed. See also MPEP 2173.05(b) and *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200 (1991) where the court held that claims reciting "at least about" were invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide

any indication as to what range of specific activity is covered by the term "about."

Specific guidance in the specification has not been found.

During patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 320,322 (Fed. Cir. 1999). In determining the patentability of claims, the PTO gives claim language its broadest reasonable interpretation" consistent with the specification and claims. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See MPEP § 904.1.

Usually the terms "machine direction" and "cross machine direction" are used in the art by referring to the transport of a web through a processing machine. However appellant defines these terms as inherent properties within the web. The examiner recognizes that applicants are entitled to be their own lexicographers as described in MPEP 2111.01(IV). Appellant defines the terms as inherent tensile strength properties within the web and compares the ratios to one another. Looking to the Specification, appellant describes on page 21 that a preferred embodiment of the machine direction to the cross machine direction is a 1 to 1 ratio therefore being "square"; see paragraph 3. The examiner has determined that in a 1 to 1 ratio there is no difference in either direction of the tensile strength of the paper. Therefore contesting the prior art on the basis that it does not teach paper webs aligned in the claimed direction is inaccurate. The cited prior art references are silent as to which direction the fibers of the paper are aligned.

The paper towels of Lazar are considered single ply paper napkins. Nothing in appellant's specification precludes this interpretation or differentiates the single ply napkins from the single ply paper towels of Lazar. This interpretation is consistent with MPEP 904.1, *In re Zletz* and *In re Morris, supra*.

The folds in Lazar are considered transverse folds; see figures 4-7. Regarding the scale of the drawings, MPEP 2125 does not preclude an interpretation of what they (drawings) would reasonably teach one of ordinary skill in the art; *In re Wright*, 569 F.2d 1124 (CCPA 1977). The drawings of Lazar, Chan, and Ito are not relied upon to scale but rather what they convey to one of ordinary skill in the art along with the written description. Appellants arguments referring to specific measurements of the figures of the prior art references is exactly what the MPEP refers to as showing what is considered of "little value" ie. relying upon exact scaling to differentiate.

The argument that Lazar, Chan, or Ito necessarily teaches a transverse fold in the machine direction is not agreed with. One of ordinary skill in the art would not necessarily position the paper webs as argued as paper can be made and cut in a variety of ways. Furthermore, as noted *supra*, each reference is silent to the machine and cross machine directions of the tensile strength of the paper. However, as noted *supra*, given the appellant's definition a 1 to 1 ratio of these properties provides for no difference in the labeling of directions/dimensions.

Regarding the obviousness rejections:

Note that a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its

actual application is beyond that person's skill. While evaluating obviousness, one must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions; see *KSR Int. v. Teleflex 550 US*__(2007).

To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art; *ibid*.

The analysis need not seek out precise teachings directed to the challenged claimed specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ. Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed; *ibid*.

Regarding applicant's admitted prior art (AAPA) relied upon, note that in order to adequately traverse such a finding (OFFICIAL NOTICE), an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See MPEP 2144.03(c) and also Chevenard, 139 F.2d at 713, 60 USPQ at 241. The arguments on pages 10-11 in the action of 10/6/05 only refer to discussion of the folding process of Lazar and therefore are not a specific traversal nor considered adequate of the requirements outlined in MPEP 2144.03(c). Appellant

continues along the same lines of traversal and does not directly point out why the specific dimension or weight of the paper materially affect the process.

The proposed modifications to Lazar would merely provide a predictable resulting product.

Regarding Ito, the four ply embodiment of Ito is not exclusive. Ito directly suggests using alternate structures of napkins including "absorbent polyolefin of a thickness which can be perforated"; see column 7, lines 44+. The argument that a single ply would render the prior art as unsatisfactory for its intended purpose is an unsupported conclusion by appellant. One of ordinary skill in the art could easily ascertain the modification including a single ply of absorbent polyolefin of a thickness not to preclude perforations. Thickness of the ply is recognized as directly related to strength of a ply. This modification would yield a predictable result.

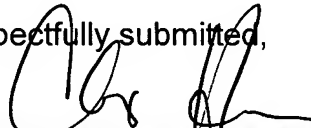
Conclusion: Appellant's arguments of what the prior art describes are unsupported conclusions as to the paper positioning. Furthermore, given appellant's definition of machine and cross machine directions, as noted supra, any arguments based upon differentiating the paper positioning in the prior art from appellant's invention are obviated.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

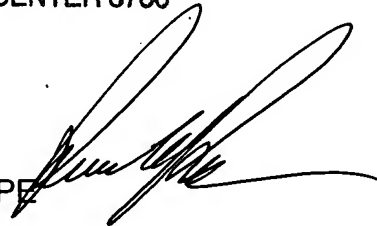
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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Conferees:

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